

II. Remarks

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1, 46, 49 and 75 have been amended. Claims 48, and 80 to 89 have been cancelled without prejudice or disclaimer. New claims 90 to 100 have been added. Claims 1 to 47, 49 to 79 and 90 to 100 are now pending in the present application and are believed to distinguish patentably over the prior art.

In the Official Action, the Examiner has rejected claims 1 to 3, 5 and 6 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,734,375 to Knox et al. ("Knox"). Claims 1, 19, 20, 36, 38, 43 and 44 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,107,522 to Walter ("Walter"). Claims 46 to 48, 75 and 76 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,484,966 to Segen ("Segen"). Claims 21 to 30, 33, 37, 39 and 40 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Walter. Claim 45 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Walter in view of U.S. Patent Application Publication No. US 2001/0022579 to Hirabayashi ("Hirabayashi"). Claims 77 to 79 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Segen in view of Walter. Applicants thank the Examiner for identifying allowable subject matter in claims 4, 7 to 18, 31, 32, 34, 35 and 49 to 74. Applicants respectfully submit, however, that the claims submitted herewith distinguish patentably over the cited references and should be allowed.

Independent claim 1 as amended recites that the non-reflective region is sized to eliminate overlapping images of the pointer appearing in the captured images. By providing such a non-reflective region, the resolution of the apparatus in certain areas of the region of interest is improved. Applicants respectfully submit that none of the references cited by the Examiner, either alone or in combination, teaches or suggests the Applicants' invention as claimed. Accordingly, Applicants respectfully submit that independent claim 1 and the claims dependent thereon, distinguish patentably over the cited references and should be allowed.

Furthermore, in regard to the rejection of claims 21-30, 33, 37, 39, and 40, 45, and 77-79, under 35 U.S.C. § 103(a), the Applicants respectfully submit that the Examiner has failed to provide a legally cognizable motivation for combining the prior art references.

In regard to claims 21 and 22, the Examiner asserts that “it would be well within the skill of those of ordinary skill in the art at the time when the invention was made that it (i.e., how the corrugated reflective elements 12 of Walter are made) that it can be realized by depositing a reflective coating on a corrugated surface. And as can be seen from the FIGS. 1-5 the thickness of corrugated material indeed defines opposed major surfaces, one of said major surfaces defining said corrugated surface and another of said major surface being generally planar.” [Office Action, page 6] Notwithstanding what Walter allegedly discloses, the Applicant respectfully submits that the Examiner fails to provide any legally cognizable motivation. Instead, the Applicants respectfully submit that the Examiners motivation is non-existent and nothing more than hindsight reconstruction, impermissible under the applicable patent law. Further still, the Applicants respectfully submits that for claims 23-30, 33, 37, 39, and 40 the Examiner fails to provide any motivation, legally cognizable or otherwise. Therefore, the Applicant respectfully submits that the rejection of claims 21-30, 33, 37, 39, and 40 under 35 U.S.C. § 103(a) as being unpatentable over Walter is in error, and should be withdrawn.

In regard to claim 45, the Examiner merely states that “[i]t would have been obvious to one of ordinary skill in the art at the time when the invention was made *that the imaging device taught by [Hirabayashi] can be suitably used in the apparatus of Walter without undue experimentation or bringing about any unexpected result.*” [Office Action, page 7 (emphasis added)] The Applicant respectfully submits that the Examiner’s alleged motivation is non-existent and nothing more than hindsight reconstruction, impermissible under the applicable patent law. Therefore, the Applicant respectfully submits that the rejection of claim 45 under 35 U.S.C. § 103(a) as being unpatentable over Walter in view of Hirabayashi is in error, and should be withdrawn.

In regard to claims 77-79, the Examiner provides that “[i]t would have been obvious to one of ordinary skill in the art at the time when the invention was made in view of Walter to modify the reflective surfaces of Segen arranged at generally right angles in [a] V-configuration because it would allow to reduce [sic] the adverse affect of ambient light (Walter; col. 4, lines 30-32).” [Office Action, page 8]

Respectfully, the Applicant submits that the following, which is a more complete recitation of the relevant portion of Walter, shows that Walter fails to disclose a motivation for combining Walter with Segen:

According to a variant of the embodiment of FIGS. 1 and 2 working takes place with alternating light instead of constant light. The transmitting light beam 11 can for example be produced by a light-emitting diode 20 driven by a high, e.g. radio frequency source 21 to correspondingly modulate the emitted light, whereby preferably a selective receiver is used.

In this case it would not be possible to in practice influence the apparatus by outside light, because the latter would be filtered out in the selective receiver. The apparatus of FIG. 2 would also have this advantage when using a selective receiver following the photo-receiver in the light transmitter-receiver 17.

[Walter, col. 4, lines 23-35 (emphasis added)]

The Applicant respectfully submits that the relevant portion of Walter shown above is not-related to the modification of reflective surfaces in a V-configuration; instead, Walter discusses reduction of the outside influence of light due to a selective receiver. The Applicant respectfully submits that the Examiner’s alleged motivation is non-existent and nothing more than hindsight reconstruction, impermissible under the applicable patent law. Therefore, the Applicant respectfully submits that the rejection of claims 77-79 under 35 U.S.C. § 103(a) as being unpatentable over Segen in view of Walter is in error, and should be withdrawn.

Independent claims 46 and 75 have been amended to recite subject matter similar to that recited in independent claim 1, which is deemed allowable.

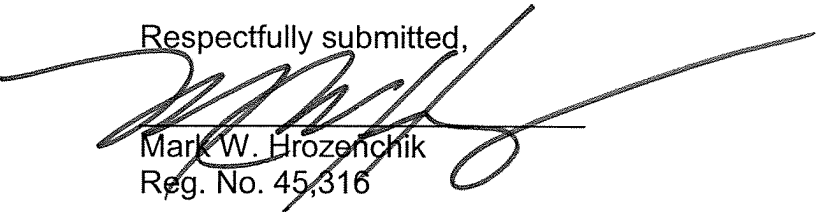
Accordingly, Applicants respectfully submit that these claims and the claims dependent thereon, distinguish patentably over the cited prior art and should be allowed.

New independent claim 90 recites the subject matter of original claims 1 and 8. As the Examiner has identified claim 8 as reciting allowable subject matter, Applicants respectfully submit that this claim and the claims dependent thereon, distinguish patentably over the cited prior art and should be allowed.

In view of the above, it is believed the application is in order for allowance and action to that end is respectfully requested.

It is believed that no other fees are due, other than the fees for the extension of time of one (1) month to respond to the Office Action mailed October 17, 2006, as stated above. However, should additional fees be deemed necessary to maintain pendency of this application under 37 C.F.R. §§ 1.16 and 1.17, the Commissioner is hereby authorized to charge any, or credit any overpayments, to Deposit Account No. 50-1710.

Respectfully submitted,



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